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REMARKS

Claims 1-10 and 30-48 are pending in the present application. In the Office Action mailed January 12, 2005, the Examiner set forth a restriction of claims 1-10 and 30-48. The Examiner also rejected claims 1-10 and 30-39 under 35 U.S.C. §103(a) as being unpatentable over Barrett et al. (USP 6,029,144).

The Abstract was objected to because its length exceeded 150 words. Applicant has herein amended the Abstract to conform to proper format requirements.

ELECTION WITH TRAVERSE

The Examiner identified two groupings of claims, Group I containing claims 1-10 and 30-39, and Group V containing claims 40-48. Applicant elects, with traverse, Group I, claims 1-10 and 30-39.

TRAVERSAL REMARKS

With respect to the restriction requirement, the Examiner concluded that "as a result of the unusual prosecution history of the present Application, claims 1-10 and 30-48 are pending." Accordingly, Applicant believes it necessary to first highlight the "unusual" history of the present application in order to provide a context for the Examiner's remarks and Applicant's Response thereto. In the Office Action of October 19, 2004, the Examiner described new claims 30-48 as a part of a "proposed amendment" that was "subject to restriction" but only if "formally entered." Thus, it appears the Examiner did not consider claims 30-48 to have been entered at that time. In Applicant's Remarks of October 29, 2004, no indication was given as to whether or not it was desired that the claims be "formally entered." In the present Office Action, the Examiner concluded that, due to the timing of Office Actions and Responses, and the withdrawal of the Office Action of July 13, 2004, claims 30-48 have now been entered. Thereafter, the Examiner stated that "[s]ince applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 40-48 are withdrawn from consideration as being directed to a non-elected invention." (Emphasis added.) Thus, in a single Office Action, the Examiner "formally entered" claims 30-48, issued a restriction requirement, elected a claim group on Applicant's behalf, and withdrew claims 40-48.

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Applicant is unaware of a doctrine of "constructive" election. Prior to this Response, Applicant had not yet elected either Group I or Group V, "constructively" or otherwise. The present Office Action is the first time Applicant has been formally presented with this restriction requirement. Therefore, Applicant now elects Group I with traverse. While the Examiner purported to make the restriction final based on the "constructive election" of Group I, Applicant is entitled to formally elect claims and offer remarks in favor of traversal and rejoinder of all claims. MPEP §818.03. Applicant now chooses to do so and believes that there is no basis for restricting claims 1-10 and 30-39 and claims 40-48.

Group I, claims 1-10 and 30-39, was identified in the Office Action of July 28, 2003, in class 705, subclass 26 ("Electronic Shopping") as drawn to a method for designing an electronic transaction system. Group V, claims 40-48, was identified in the present Office Action in class 709, subclass 223 ("Computer Network Managing") as drawn to "a system." In the present Office Action, the Examiner stated that the groups are "related as process and apparatus for its practice." As proof that the groups are distinct, the Examiner further stated that "the apparatus can be used to practice a credit analysis process." In contrast, Applicant believes that (1) the claim groupings are not distinct because they are interrelated, (2) that the Examiner has not substantiated a basis for rejection, and (3) there is no reason for insisting on restriction.

An examination of the elements of the claim groupings evidences the interrelation therebetween. For example, claim 1 of Group I calls for the step of "reviewing existing direct sales screening processes to ensure current policy compliance." Similarly, claim 40 of Group V recites a computer system configured to "review existing direct sales screening processes to determine whether the medical device sales requests and associated legal terms and conditions meet current policy compliance." Further, claim 1 calls for "legal terms and conditions for the electronic transactions," and claim 40 recites "sales requests and associated legal terms and conditions." Claim 1 calls for "a global communications network," while claim 40 is directed to a "system for initiating electronic sales of medical devices over a global communications network." One of ordinary skill in the art would readily recognize the similarity between the elements of these claims.

In fact, nearly every element of claim 40 of Group V is related to an element of one or more claims in Group I. In particular, dependent claim 7 of Group I calls for a computer program which causes a computer to acquire "a product order specifying a desired product from a customer at a user interface, so that the customer may access an automated seller facility."

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Likewise, claim 40 calls for “a user interface configured to receive medical device sales requests.” Claim 7 also calls for a determination of “whether the desired product is in the restricted product category.” Correspondingly, claim 40 calls for “a filter mechanism” to identify “parameters matching prohibited transaction criteria.” And, claim 7 calls for the computer to “accept the product order if either the customer is an authorized buyer ... or if the desired product is in the unrestricted product category ... and if not, reject the product order,” while claim 40 calls for a computer system configured to “determine at least one of an acceptance or rejection of medical devices sales requests.”

Beyond the overlapping scope of the claims of Groups I and V, the Examiner’s proffered basis for restriction is unsupportive. The Examiner stated that Group I and Group V are “related as process and apparatus for its practice,” and that “the apparatus can be used to practice a credit analysis process.” Thus, the Examiner has essentially stated that credit analysis is a materially different process from that called for in Group I. However, the Examiner has not presented any reasoning to show why a credit analysis process could be performed by the “apparatus” of Group V, but would not fall within the scope of Group I. In fact, not only has the Examiner failed to establish why credit analysis does not fall within the general scope of Group I, customer credit considerations are explicitly recited in several claims of Group I. For example, claims 4 and 36 both recite the steps of “developing customer credit worthiness procedures” and “ensuring customer credit worthiness procedures are implemented and followed.” Therefore, the explicit elements of the claims are directly contrary to the basis for restriction proffered by the Examiner.

In addition, MPEP §808.02 requires that “reasons for insisting on restriction” must be shown “by appropriate explanation.” In the present restriction requirement, the Examiner has not explicitly asserted any of the three possible reasons for insisting on restriction laid out in §808.02, and thus has not presented “appropriate explanation.” Nevertheless, no additional burden would, in fact, result from examination of both groups. Group I was identified as falling within class 705, subclass 26, (“Electronic Shopping”), as drawn to a method for designing an electronic transaction system. Group V was identified in class 709, subclass 223 (“Computer Network Managing”), as drawn to “a system.” More particularly, claim 40 of Group V is drawn to “a system for initiating electronic sales...” Therefore, a proper search of Group V would require a search of class 705, subclass 26, “Electronic Shopping,” and would overlap a proper search for Group I.

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It is apparent that the subject matter of Group V is not so divergent from the subject matter of Group I so as to necessitate a requirement for restriction. Accordingly, Applicant requests that claims 1-10 and 30-39 and claims 40-48 be rejoined.

CLAIM REJECTIONS

In the rejection of claims 1-10 and 30-39 under 35 U.S.C. § 103(a), the Examiner stated that the claims are unpatentable over Barrett et al. Thereafter, the Examiner took Official Notice of every element of all pending claims, except elements (e) and (f) of claim 1. Apparently, in regard to elements (e) and (f) of claim 1, the Examiner concluded that posting business practices via electronic media on a global communications network would have been obvious to one of ordinary skill in the art. Thus, Barrett et al. is included in the formal rejection of the claims, but never applied in a particularized way to any claims or elements thereof.

While the Examiner did state that Barrett et al. "discloses a policy checker 208, e.g. Figs. 3 and 4, that reviews existing and new audit screening processes," the Examiner did not relate how such teaching is applicable to that which is claimed. The Examiner also did not indicate how or whether such teaching correlates in some way to the Examiner's broad use of Official Notice. Regardless, Barrett et al. is non-analogous and does not teach or suggest the claimed invention. That is, Barrett et al. is directed to "automated employee expense reimbursement auditing." Col. 1, lns. 8-9. Employee expense reimbursement is a cash outflow occurring between an employer and its employees. Col. 5, lns. 1-11; col. 6, lns. 49-57. In contrast, the claimed invention is directed to a system for electronic transactions and sales, which includes cash inflows between a business and its customers. Furthermore, Barrett et al. does not specifically teach a system for electronic transactions. Therefore, Barrett et al. does not appear to be particularly relevant to the claimed invention, and the Examiner apparently did not rely on Barrett et al. for the substance of the rejection of claims 1-10 and 30-39.

Rather than provide and apply a proper prior art reference or combination of references to the claimed invention, the Examiner instead improperly relied on Official Notice to provide a basis for rejecting nearly all pending claim elements. Official Notice is a doctrine which may be used to "fill in the gaps" between other documented evidence when the noticed facts are "capable of such instant and unquestionable demonstration as to defy dispute." *In re Ahlert*, 424 F.2d 1088, 1091-92, 165 USPQ 418, 420-21 (CCPA 1970). According to MPEP §2144.03, Official Notice "may provide sufficient support for conclusions only as to peripheral issues." (Emphasis

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added.) Furthermore, "assertions of ... specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art." MPEP §2144.03; *Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21 (stating "we reject the notion that judicial or administrative notice may be taken of the state of the art. The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amenable to the taking of such notice."). In addition, as particularly applied to obviousness rejections, assertions of the "basic knowledge" or "common sense" of one of ordinary skill in the art requires the support of specific factual findings and concrete evidence in the record. Without such, an obviousness rejection based on Official Notice cannot be sustained. MPEP §2144.03; *In re Zurko*, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001).

In the instant case, Official Notice constitutes the basis for the vast majority of the rejection, rather than a gap-filler. Official Notice has been applied broadly rather than judiciously; to nearly all limitations of all claims, rather than "peripheral" issues. The Examiner also did not recite any particular facts taken by Official Notice which render the claims obvious. Rather, the Examiner made the conclusory statement that Official Notice is taken of the claim elements themselves.

Specifically, the Examiner stated that the noticed claims and limitations "have been common knowledge in the business world predating Applicant's filing date of the present application." Not only is this conclusory, but it is an assertion of the state of the art at some previous point in time, and cannot be relied upon without documentation and concrete support in the record. MPEP §2144.03. A conclusion that the specific subject matter claimed by Applicant is or was known must be supported by "some reference work recognized as standard in the pertinent art." *Id.* However, the present rejection lacks such support. The Examiner has not set forth the required factual findings or concrete evidence.

Applicant believes that the Examiner's failure to include this support is due to the fact that no such evidence or documentation exists to render the claims obvious. Specifically, Applicant believes that at least as of November 9, 2000, the filing date of the present application, it was not common knowledge in the business world to practice Applicant's invention as claimed. In general, an Examiner's search and cited references are indicative of knowledge commonly held in the art. Yet the Examiner only included one reference in the rejection of the claims, Barrett et al., which, as previously shown, is non-analogous art and was not specifically applied to even a single limitation out of all 20 claims spanning almost 7 pages. Since the Examiner must cite the

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best reference available, and since a reference was included but not specifically applied, it would appear that known art does not disclose all limitations of the present invention.

Furthermore, there is no showing whatsoever that the allegedly well known elements were all contemporaneously well known before Applicant's filing date. The bare assertion that the noticed subject matter has "been common knowledge in the business world predating Applicants filing date of the present application" does not establish that all the elements of the present claims were known to one of ordinary skill in the art at the same time. The Examiner presented absolutely no basis from which to conclude that the subject matter of every limitation of all claims, except steps (e) and (f) of claim 1, were simultaneously known in the art at some date before the present application was filed.

Thus, there is no support for asserting Official Notice in the instant case. Without a showing of concrete evidence and documentation proving that an individual possessing ordinary skill in the art would have contemporaneously known all Officially Noticed limitations, Official Notice may not be relied upon. MPEP §2144.03. Applicant has pointed out that this use of Official Notice is improper and thus has adequately traversed this use of Official Notice. *See Id.* ("to adequately traverse [the use of Official Notice], an applicant must specifically point out the supposed errors in the examiner's action"). Therefore, the rejection of claims 1-10 and 30-39 must be withdrawn. However, should the Examiner continue to rely on Official Notice, Applicant requests specific references be supplied to substantiate each and every application of Official Notice and explanation of the applicability of the references to each and every element of the pending claims.

In addition, the Examiner's statements asserting the obviousness of steps (c) and (f) of claim 1 are no longer applicable in light of the fact that Applicant has traversed the use of Official Notice. Step (e) recites "forming electronic media for steps (a) through (d)," and step (f) recites "posting the electronic media on a global communications network." Since the Examiner improperly relied on Official Notice in regard to steps (a) through (d), those steps have not been shown to be obvious. Therefore, steps (e) and (f), as relating back to steps (a) through (d), cannot be said to be obvious. Without Official Notice as a basis, the Examiner's comments in regard to steps (e) and (f) are unsubstantiated and do not support a rejection of claim 1.

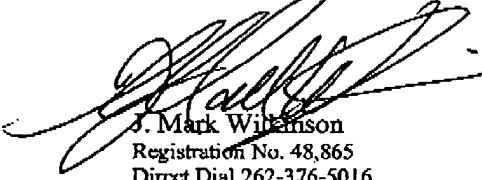
In sum, the teachings of Barrett et al. are not analogous and have not been specifically applied to the elements of the pending claims. Additionally, as shown, the Examiner's use of Official Notice was improper. Similarly, there is no applicable basis for rejecting claims 40-48.

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Therefore, once properly rejoined, claims 40-48 are also believed allowable. As a result, Applicant respectfully requests timely issuance of a Notice of Allowance for claims 1-10 and 30-48. Applicant appreciates the Examiner's consideration of these Remarks and cordially invites the Examiner to call the undersigned, should the Examiner consider any matters unresolved.

Respectfully submitted,



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